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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/574,679	04/04/2006	Peter Hupfield	MSP642PCT1	1749
137 7590 06/30/2008 DOW CORNING CORPORATION CO1232 2200 W. SALZBURG ROAD P.O. BOX 994 MIDLAND, MI 48686-0994				
EXAMINER LOEWE, ROBERT S				
ART UNIT 1796		PAPER NUMBER		
NOTIFICATION DATE 06/30/2008		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents.admin@dowcorning.com

### Office Action Summary

**Application No.**

10/574,679

**Applicant(s)**

HUPFIELD, PETER

**Examiner**

ROBERT LOEWE

**Art Unit**

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Applicant's arguments/remarks, filed on 5/27/08, have been fully acknowledged.

#### ***Priority***

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Great Britain on 11/21/03. It is noted, however, that applicant has not filed a certified copy of application GB-0327067.5 as required by 35 U.S.C. 119(b). The Examiner awaits confirmation from Applicant's regarding this matter.

#### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The rejections made in the previous Office action, dated 12/10/07, are wholly maintained.

#### ***Response to Arguments***

Applicant's arguments filed 5/27/08 have been fully considered but they are not persuasive.

Applicants argue that the 103(a) rejection of record (Eguchi et al. in view of Smith et al.) fails to account for major differences between the cited references. Specifically, Applicant's state that Eguchi et al. teaches rubber stoppers having fluorinated surfaces to prevent contamination of the impurities present in the rubber stoppers with external additives present in a system comprising the stopper. Applicants further state that Smith et al. is concerned with

improving the durability of fluorocarbon treatments, such as fluorocarbon coated textiles. The fact that Eguchi et al. and Smith et al. are concerned with solving different technical problems is nevertheless offset due to the chemical makeup of the compositions employed by each teaching. Specifically, both disclosures rely on polymers which are prepared by reacting perfluorinated monomers with a reactive non-fluorinated acrylate, such as glycidyl methacrylate. The chemistry disclosed in each prior art teaching is similar. As such, the similar chemistries taught by Eguchi et al. and Smith et al. render these references as properly combinable. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Specifically, a person having ordinary skill in the art would not have disincentive to look towards the teachings of Smith et al. in an effort to modify the compositions taught by Eguchi et al. simply because they are concerned with solving different technical problems. It is the chemistry taught by each reference which renders the two references properly combinable.

Applicant's further argue that there is no motivation to combine the teachings of Eguchi et al. and Smith et al. to arrive at the instant claims. Specifically, Applicants argue that the reason the compositions of Smith et al. are oil and water-repellant is due to the perfluorinated groups. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the

knowledge generally available to one of ordinary skill in the art. The compositions taught by Smith et al. are shown to have good stability towards dry-cleaning and laundering processes (see examples of Smith et al.). The compositions taught by Eguchi et al. are required to be stable to steam treatment (as for example in a sterilization process) (9:10-12). The compositions taught by Smith et al. bode well for incorporation into the compositions taught by Eguchi et al. owing to the precedent that such compositions would hold well under such steam-treatment processes. In addition, because Eguchi et al. relies on acrylic-based reactive copolymers, it would be logical to employ acrylic-based perfluorinated monomers as well, such as those taught by Smith et al., so as to match the reaction chemistry displayed by both the perfluorinated and non-fluorinated functional acrylic-based monomers. In other words, if both monomers are acrylic-based, they would have similar rates of reaction. Last, the perfluorinated acrylic monomers taught by Smith et al. have even longer perfluorinated segments than those taught by Eguchi et al. As such, a person having ordinary skill in the art would have expected improved oil and water-resistant properties when employing the fluorinated monomers taught by Smith et al. in the compositions taught by Eguchi et al. since it is well-known that increasing the perfluoroalkyl group content in a system will render the system more hydrophobic.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### *Correspondence*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Loewe whose telephone number is (571) 270-3298. The examiner can normally be reached on Monday through Friday from 9:30 AM to 7:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Eashoo can be reached on (571) 272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number: 10/574,679

Page 6

Art Unit: 1796

/R. L./

Examiner, Art Unit 1796

20-Jun-08

/Randy Gulakowski/

Supervisory Patent Examiner, Art Unit 1796